

REMARKS:

In the Specification

The changes suggested by the Examiner have been made. Withdrawal of the objection is respectfully requested.

Allowable subject matter

Applicants acknowledge and appreciate indication of allowable subject matter in claims 5, 6, 8-10 and 12-15.

102 rejection

Claims 1-3 and 11 have been rejected under 35 USC 102(b) as being anticipated by Gill (US6570745).

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, the identical invention must be shown in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Regarding claims 1-3 and 11, the claims require the steps of adding a protective layer to the wafer stack such that the gap is covered, the protective layer also covering facing ends of the leads; removing material from at least one side area of the wafer stack using the protective layer as a mask; and removing the protective layer.

The rejection cites Gill element 104 to show the protective layer. However, as noted in col. 3, line 61, element 104 is an insulation layer. As shown in Gill Figs. 3-5, the insulation layer 104 overlies the entire structure, and so the insulation layer 104 does not act as a mask for the structures shown. Further, Gill does not remove insulation layer 104. Accordingly, the rejection violates the rules of *Verdegaal Bros.*, *supra* and *Richardson*, *supra*.

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The rejection also cites element 94 as a mask. As noted in col. 3, line 57, element 94 is a lead element. However, what is claimed is that the protective layer, not the leads, acts as a mask. Accordingly, the rejection violates the rules of *Verdegaal Bros.*, *supra* and *In re Bond*, *supra*. And even if Gill's lead element 94 were used as a protective layer, it could not be removed, as to do so would render Gill's device inoperable.

For any of the foregoing reasons, the rejection of claims 1-3 and 11 is improper and must be withdrawn.

103 rejection

Claims 4 and 7 have been rejected under 35 USC 103(a) as being unpatentable over Gill in view of Chang (US6434814).

The rejection applies Gill as for claim 1. Claims 4 and 7 depend from claim 1, and therefore the rejection suffers from the same deficiencies as set forth above with respect to claim 1. Because Chang has merely been added to allegedly show the limitations of claims 4 and 7, claims 4 and 7 are believed to be allowable over the combination of art proposed by the Examiner. Reconsideration and allowance of claims 4 and 7 is respectfully requested.

Claim 38

Upon allowance of claim 1, Applicants respectfully request rejoinder of claim 38.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 971-2573. For payment of any additional fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-2587 (Order No. SJO920020132US1).

Respectfully submitted,

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